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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 10/098,545  | 03/18/2002  | Takumi Takahashi     | 03500.016292              | 4950             |
| 5514  | 7590        | 10/21/2005           | EXAMINER                  |                  |
| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      | DURNFORD GESZVAIN, DILLON |                  |
|   |             |                      | ART UNIT                  | PAPER NUMBER     |
|   |             |                      | 2615                      |                  |

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                     |  |
|------------------------------|--------------------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>               | <b>Applicant(s)</b> |  |
|                              | 10/098,545                           | TAKAHASHI, TAKUMI   |  |
|                              | Examiner<br>Dillon Durnford-Geszvain | Art Unit<br>2615    |  |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-12 and 14-39 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-12 and 14-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Objections***

2. Claim 11, 28, 37 and 39 objected to because of the following informalities: in claim 11, "an image that correspond to" should be --an image that corresponds to--. In claim 28, "determination mean" should be --determination means--.

As to claim 37, "method according to claim 36" should be --image storage device according to claim 36--.

As to claim 39, it appears that this claim should be dependant on claim 38 and not claim 34 as it is written.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0041056 (Tanaka et al. hereinafter Tanaka (US)) in view of Japanese Published Patent Application H06-233044 (Tanaka et al. hereinafter Tanaka JP).

As to claim 1, Tanaka (US) teaches a method for displaying on an image display device 80 an image stored in an image storage device 10 comprising: receiving and displaying file list information on the image receiving device 80 (see [0088]). Further comprising receiving and displaying thumbnail information corresponding to the file list information previously received (lines 4-8 of [0091]).

Note that Tanaka (US) teaches listing both the file name 128 and thumbnail information 86 corresponding to that file name as shown in Fig. 5.

Tanaka (US) does not teach a determination step for determining if an image is to be displayed or characters (i.e. a name) is to be displayed, in accordance with the number of images stored in the image storage device.

However, Tanaka (JP) teaches a method for receiving images with an image reception device (a fax machine) that employs a determination step as to whether to output the images or a report about the images depending on whether the number of received images is greater than a threshold value ([0028]). Note that hereinafter the Examiner interprets the disclosure in [0029] in the last three lines in which it states "the information may be reduced information of a plurality of pages," as including the names of images when this teaching is applied to the transfer of images between an image storage device and an image receiving device as taught by Tanaka (US).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a determination step as taught by Tanaka (JP) in the image transfer method of Tanaka (US) as this would allow a user to find a desired picture more quickly if there are a large number of images by searching through only the

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names (as when there are also thumbnails displayed it takes longer to page through the images as anyone who has done this knows) and when there are a relatively small number of images it allows the user to find the desired image more accurately as they can see a thumbnail and visually confirm that it is the correct image.

As to claim 4, Tanaka (US) and Tanaka (JP) have been described above. As discussed above Tanaka (US) teaches displaying an image and displaying the name of an image. What it doesn't teach is determining if only the name or only the image is to be displayed. However, Tanaka (JP) teaches an image receiving device that outputs image data that uses a method employing a determination step to determine if the image data should be output or a report about that image data should be output depending on the number of images received.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the determination step of Tanaka (JP) in the image display method of Tanaka (US) to determine if image data should be output or a name associated with that image should be output as if there are a large number of images in the image storage device 10 it would take a much longer time to display all of the images than to display only the names of the images and this would provide a faster way to search through a large number of images stored in an image storage device.

As to claim 5, see the rejection of claim 4 and note that Tanaka (US) further teaches a name display step of displaying names of multiple images (128 of Fig. 5); and

an image display step of displaying one of the multiple images whose names are displayed (86 of Fig. 5).

As to claim 6, this claim is analogous to claim 1 except the applicant specifies that the image storage device determines if image data is to be transmitted or identification of the image data is to be transmitted (instead of displayed) in accordance with the number of images stored in the storage device. What Tanaka (US) and Tanaka (JP) teach has been discussed above. Tanaka (US) describes a "pull" model of receiving image data wherein the image receiver 80 requests information from the image storage device 10 ([0133]). However, Tanaka (US) would have considered a "push" model wherein the image storage device 10 initiates the transfer of images and in this case it would be the image storage device that performs the determination step taught by Tanaka (JP).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the determination step as taught by Tanaka (JP) in a "push" model of the image transfer system taught by Tanaka (US) as this would allow for faster transfer of data when the amount of images stored on the image storage device is large as images contain much more data than characters and this would facilitate a faster transfer of the desired images.

As to claim 7, see the rejection of claim 6 and note that Tanaka (US) further teaches a wireless transmission step of the image storage device transmitting, using

wireless communication, the image data or characters related to the image data to the image reception device (see Fig. 7 and Fig. 2 and [0037]).

As to claim **8**, this claim is analogous to claim **6** except the applicant specifies "identification of the image data" as "an image name." The Examiner states that the grounds for rejection applicable to claim **6** are also applicable to claim **8** since the identification of the image data that Tanaka (US) uses is an image name (see Fig. 5 and [0059] line 14 or line 4 from the bottom).

As to claim **9**, see the rejection of claim **8** and note that Tanaka (US) further teaches a display step of displaying multiple names (see Fig. 5) that are transferred; and a transmission step of transmitting from the image storage device to the image reception device image data in accordance with one of the displayed multiple names (see [0088] and [0089]).

As to claim **10**, this claim is analogous to claim **1** except it is drawn to a device that carries out the method of claim **1**. Therefore, the same grounds for rejection can be made for claim **10** as for claim **1** except drawn to the device taught by Tanaka (US) in view of Tanaka (JP). Note that Tanaka (US) teaches a display means 88.

As to claim **12**, this claim is analogous to claim **4** except it is drawn to device that carries out the method of claim **4**. Therefore, the same grounds for rejection can be

made for claim **12** as for claim **4** except drawn to the device taught by Tanaka (US) in view of Tanaka (JP). Note that Tanaka (US) teaches a display means 88.

As to claim **14**, this claim is analogous to claim **10** except it is drawn to a program for the device of claim **10**. Since there must be a program for making the device of claim **10** perform the method of claim **1** the same argument and grounds for rejection can be made for claim **14** as for claims **1** and **10** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP).

As to claim **16**, this claim is analogous to claim **12** except it is drawn to a program for the device of claim **12**. Since there must be a program for making the device of claim **12** perform the method of claim **4** the same argument and grounds for rejection can be made for claim **16** as for claims **4** and **12** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP).

As to claim **17**, this claim is analogous to claim **5** except drawn to a program instead of a method. Therefore the same grounds for rejection can be made for claim **17** as for claim **5** except drawn to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a method.

As to claim **18**, this claim is similar to claim **12**, except it claims an image storage device instead of an image display device. As Tanaka (US) teaches both an image

storage device 10 and an image reception device 80, the same argument can be made for the rejection of claim 18 as that made for the rejection of claim 12. Note that Tanaka (US) teaches a communication means for communicating between the image storage device and the image reception device ([0037]).

As to claim 19, this claim is similar to claim 18 except the applicant specifies "an image name" instead of "identification of the image data." Since the image identification data taught by Tanaka (US) is an image name ([0059] line 14) claim 19 can be rejected with the same arguments as those made for claim 18.

As to claim 20, this claim is analogous to claim 19 except that is drawn to a program instead of an apparatus. However, since the apparatus must have a program for carrying out the functions ascribed to it, the same argument can be used to reject claim 20 as was used to reject claim 19 except drawn to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a device.

As to claim 21, this claim is analogous to claim 18 except drawn to a program instead for the apparatus of claim 18. Therefore, the same argument can be made for the rejection of claim 21 as was made for the rejection of claim 18 except drawn to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a device.

As to claim 22, see the rejection of claim 1 and note that if one were to combine

the determination step of Tanaka (JP) with the image transfer method of Tanaka (US) that there would necessarily have to be a step where the number of images in the image file list would be determined. If this were not done than no comparison to a threshold would be possible as the number of images that are being transferred would be unknown. Therefore this step is taught implicitly by Tanaka (US) in view of Tanaka (JP).

As to claim 23, see the rejection of claim 1, and note that Tanaka (US) further teaches requesting the image that is to be displayed ([0088] and [0089]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have associated the step of requesting an image with the determination step as the step of requesting the image is only done if the determination step determines it is to be done and only then would the requesting step be carried out. It wouldn't make any sense to request the image without determining that the image is to be requested.

As to claim 24, see the rejection of claim 4 and as noted in the rejection of claim 22, the number of images in the list received by the image display device must be determined in order to compare that number to the threshold taught by Tanaka (JP).

As to claim 25, see the rejection of claim 4 and note that, as discussed in the rejection of claim 23, Tanaka (US) teaches a requesting step that one of ordinary skill in the art would associate with the determination step.

As to claim **26**, see the rejection of claim **10** and note that as discussed in the rejection of claim **22** the step of determining the number of image files that are in the image file list sent by the image storage device is a necessary step in the determination step taught by Tanaka (JP).

As to claim **27**, see the rejection of claim **10** and note that claim **27** is a device performing the method of claim **23** and is rejected using the same grounds for rejection of claim **23** as applied to the device of claim **10** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **28**, see the rejection of claim **12** and note that as discussed in the rejections of claim **22** the step of determining the number of image files is a necessary step that is implicitly taught by the Tanaka (US) in view of Tanaka (JP).

As to claim **29**, see the rejection of claim **12** and note that claim **29** is similar to claim **27** except the claim which it is dependent upon uses the name of an image to identify images instead of characters related to an image. However, as Tanaka (US) teaches using characters to specify image names this claim can be rejected under the same grounds as claim **27**.

As to claim **30**, see the rejection of claim **14** and note that claim **30** is a program

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that performs steps corresponding to the steps of claim **22** and is rejected using the same arguments as those used to reject claim **22** except drawn to the program of claim **14** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **31**, see the rejection of claim **14** and note that claim **31** is a program that performs steps corresponding to the steps of claim **23** and is rejected using the same arguments as those used to reject claim **23** except drawn to the program of claim **14** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **32**, see the rejection of claim **16** and note that claim **32** is a program that performs steps corresponding to the steps of claim **24** and is rejected using the same arguments as those used to reject claim **24** except drawn to the program of claim **16** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **33**, see the rejection of claim **16** and note that claim **33** is a program that performs steps corresponding to the steps of claim **25** and is rejected using the same arguments as those used to reject claim **25** except drawn to the program of claim **16** as taught by Tanaka (US) in view of Tanaka (JP).

As to claim **34**, Tanaka (US) teaches a method for transmitting image data from an image storage device from an image reception device, comprising: a reception step of receiving a request from the image reception device ([0089]).

What Tanaka (US) does not teach is a transmission step of transmitting data of a kind corresponding to the number of images to the image reception device. The Examiner interprets this limitation as meaning that the image storage device either transmits image data or names of images depending on how many images are stored in the storage device.

Tanaka (JP), as discussed above, teaches a determination step to determine if image data should be outputted or characters related to the images should be outputted depending on whether the number of images is above a threshold or not. As discussed in the rejection of claim 6, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed the determination step taught by Tanaka (JP) in the image storage device taught by Tanaka (US) before transmitting data as this would allow for more efficient transfer of data since images contain much more information than names. Note that the type of data transferred would then depend on whether the number of images exceeds a threshold value.

As to claim 35, see the rejection of claim 34 and note that as discussed in the rejection of claim 6 it would have been obvious to one of ordinary skill in the art to transmit either image data or image identifying data in accordance with the number of pictures as this allows for more efficient data transfer since images contain much more information than identification data of images.

As to claim 36, this claim is a device claim corresponding to the method of claim

34, and as such is rejected under the same grounds as claim 34 as applied to a device taught by Tanaka (US) in view of Tanaka (JP) instead of a method.

As to claim 37, see the rejection of claim 36 and note that claim 37 is a device claim corresponding to the method of claim 35 and is rejected on the same grounds as claim 35 as applied to a device taught by Tanaka (US) in view of Tanaka (JP) instead of a method.

Note that the above rejection was made in light of the objection made to claim 37 above.

As to claim 38, this claim is a program claim corresponding to the method of claim 34 and is rejected on the same grounds as claim 34 as applied to a program taught by Tanaka (US) in view of Tanaka (JP) instead of a method. This program must exist in order for the processor of Tanaka (US) to perform the method of claim 34.

As to claim 39, see the rejection of claim 38 and note that claim 39 is a program claim that corresponds to the method of claim 35 and is rejected on the same grounds as claim 35 as applied to a program taught by Tanaka (US) in view of Tanaka (JP).

Note that the above claim was made in light of the objection to claim 39 in the claim objections section above.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0041056 (Tanaka (US)) in view of Japanese Published Patent Application H06-233044 (Tanaka JP) as applied to claim 1 further in view of US 6,313,877 (Anderson).

Tanaka (US) teaches a method wherein a thumbnail image display step of displaying a thumbnail image (Fig. 5 and [0090]) and a full image display step of displaying an image corresponding to the displayed thumbnail image ([0112] lines 9-12). What Tanaka (US) does not teach is displaying a plurality of thumbnail images and displaying a full sized image corresponding to one of the displayed thumbnail images.

However, Anderson teaches displaying a plurality of thumbnail images and displaying a full image corresponding to one of the displayed thumbnail images (see Fig. 5 and Column 4 lines 54-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the display style of Anderson in the image transfer system taught by Tanaka (US) in view of Tanaka (JP) as this would allow a user to see many small images and one larger image and would assist the user in readily confirming which image they want to choose when they are choosing from the plurality of thumbnails.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0041056 (Tanaka (US)) in view of Japanese Published Patent Application H06-233044 (Tanaka JP) as applied to claim 10 further in view of US 6,313,877 (Anderson).

Claim 11 is a device claim that corresponds to the method of claim 2 and is

rejected on the same grounds as claim 2 except drawn to a device instead of a method.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0041056 (Tanaka (US)) in view of Japanese Published Patent Application H06-233044 (Tanaka JP) as applied to claim 14 further in view of US 6,313,877 (Anderson).

Claim 15 is a program claim corresponding to the method of claim 2 and the device of claim 11 and is rejected on the same grounds as those two claims as drawn to a program instead of a device or method. Note that this program is necessary for the device of claim 11 to carry out the method of claim 2.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon Durnford-Geszvain whose telephone number is (571) 272-2829. The examiner can normally be reached on Monday through Friday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dillon Durnford-Geszvain

10/17/2005



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